



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
---------------	-------------	----------------------	---------------------

08/270,631 07/01/94 CONTAG

C 86000146

CAMPBELL, B. EXAMINER

18M2/0802

DEHLINGER & ASSOCIATES
PO BOX 60850
PALO ALTO CA 94306

ART UNIT PAPER NUMBER

1804

DATE MAILED: 08/02/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined *for restriction only* ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire _____ month(s), 30 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

☒ Claims 1-19 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims _____ are rejected.

5. ☐ Claims _____ are objected to.

6. ☒ Claims 1-19 are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received. ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other.

EXAMINER'S ACTION

Art Unit: 1804

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-16, drawn to methods of detecting localization and level of biocompatible entities in mammals, classified in Class 424, subclass 9.

II. Claims 17 and 18, drawn to methods for detecting transgene integration and expression in transgenic animals, classified in Class 424, subclass 9.

III. Claim 19, drawn to *Salmonella* transformed with a gene encoding a light expressing protein, classified in Class 435, subclass 252.8.

The inventions are distinct, each from the other because of the following reasons:

Groups I and II are distinct because the two methods require different starting materials and processes to achieve divergent ends. Group II requires production of transgenic animals, while group I requires administration of a light emitting conjugate. Therefore the methods are not obvious variants and are deemed patentably distinct.

Groups I and III are distinct because the method of I is not required to make the bacteria of III, nor are the bacteria of III required to practice the method of I. Even if transformed *Salmonella* were considered to be a "conjugate" as claimed in I, the groups would be distinct because the bacteria could be used for other purposes, such as *in vitro* testing of food preservatives.

Groups II and III are distinct because the method of II is not required to make the bacteria of III and the bacteria of III are not required for the method of II.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter restriction for examination purposes as indicated is proper.

Serial Number: 08/270,631

-3-

Art Unit: 1804

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce Campbell, whose telephone number is 703-308-4205. The examiner can normally be reached on Monday-Thursday from 8:30 to 5:00 (Eastern time). The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacqueline Stone, can be reached on 703-308-3153. The FAX phone number for art unit 1804 is 703-308-4312.

An inquiry of a general nature or relating to the status of the application should be directed to the group receptionist whose telephone number is 703-308-0196.

BC
Bruce Campbell
July 25, 1995


SUZANNE E. ZISKA
PRIMARY EXAMINER
GROUP 1800